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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,392	06/23/2003	Jens Nielsen	104035.263005	1693
826	7590	06/07/2004	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,392

Applicant(s)

NIELSEN ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-20 are pending in this application filed 6/23/03, which is a continuation of PCT application filed 12/20/01.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 12/23/2000. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The International Search Report cited in the IDS filed 6/23/03 has been reviewed but will not be cited because it is not prior art.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 9 and 13-16 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent

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No. 6,620,420 ('420). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4, 9 and 13-16 are generic to all that is recited in claims 1-9 of '420. That is, Claims 1-9 of '420 fall entirely within the scope of claims 1-4, 9 and 13-16 of the instant invention, or, in other words, Claims 1-4, 9 and 13-16 are anticipated by Claims 1-9 of '420. Specifically, both compositions contain water phase, lipid phase, one or more emulsifiers and one or more of ammonium acryloyldimethyltaurine/vinylpyrrolidone copolymer in the same amounts. The recitation of intended use, i.e. type of the emulsion, is not given any patentable weight. The courts have held that in composition claims "intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the claimed ingredients can be mixed to form either o/w or w/o emulsion.

5. Claims 1-4, 10 and 13-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-8 of copending Application No. 10/025,065 ('065). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4, 10 and 13-17 are generic to all that is recited in claims 1 and 3-8 of '065. That is, Claims 1 and 3-8 of '065 fall entirely within the scope of claims 1-4, 10 and 13-17 of the instant invention, or, in other words, Claims 1-4, 10 and 13-17 are anticipated by Claims 1 and 3-8 of '065. Specifically, both compositions contain water phase, lipid phase, one or more emulsifiers and one or more of ammonium acryloyldimethyltaurate/vinylpyrrolidone copolymer in the same amounts. The recitation of intended use, i.e. type of the emulsion, is not given any patentable weight. The courts have held that in composition claims "intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the claimed ingredients can be mixed to form either o/w or w/o emulsion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lanzendörfer et al. (US 6,620,420).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Lanzendörfer et al. teach o/w emulsions containing up to 90% of a water phase, up to 20% of a lipid phase, up to 5% of one or more emulsifiers and up to 5% of one or more of ammonium acryloyldimethyltaurate/vinylpyrrolidone copolymer. See Abstract; col. 2. The compositions of Lanzendörfer et al. may also contain alcohols, diols or polyols, thickeners such as cellulose derivatives, dyes or colorants in an amount of 0.1-30%, antioxidants such as vit A or vit E in an amount of 0.001-30% and other cosmetic ingredients. See col. 5, lines 1-45; col. 13, lines 11-12; col. 13, lines 26-67; col. 14, lines 13-26. The emulsifiers of Lanzendörfer et al. include nonionic emulsifiers

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such as glyceryl monostearate and ethoxylated fatty alcohols and acids. See col. 5, lines 45-67. The lipid phase includes C₁₂₋₁₅ alkyl benzoate, isotridecyl isononanoate and other cosmetic oils. See col. 3, lines 58-62. The compositions of Lanzendörfer et al. can be applied to the skin by spraying from aerosol containers, by means of a pump device, a roll-on device, etc. See col. 15, lines 11-17. The recitation of intended use, i.e. "water-in-oil emulsion", is not given any patentable weight. The courts have held that in composition claims "intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the reference teaches the claimed ingredients in the claimed amounts and proportions.

Thus, Lanzendörfer et al. teach each and every limitation of Claims 1-20.

7. Claims 1-20 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/025,065 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

8. Claims 1-6, 8-10, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Loffler (US 2001/0005737 or 6,489,395).

Since both references appear to have identical disclosures, any reference hereinafter to paragraph numbers will be based upon the US publication disclosure.

Loffler teaches cosmetic emulsions which may be of o/w or w/o type, comprising 5-95% of oil phase, 25-85% of water phase, 0.6-0.7% of ammonium acryloyldimethyltaurate/vinylpyrrolidone copolymer (Aristoflex AVC) and 0.1-5% of oligoester emulsifier. See Abstract; [0038]-[0039], [0043], Examples. The emulsions may contain glycerol, dyes, antioxidants and other additives in a total amount of 1-10%. See [0041], [0044]-[0045]. In addition to oligoester emulsifiers, the emulsions may contain non-ionic co-emulsifiers such as glyceryl monostearate and ethoxylated fatty alcohols and acids. See [0043].

Thus, Loffler teaches each and every limitation of Claims 1-6, 8-10, 16 and 17.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loffler.

Loffler applied as above. While teaching that additives and auxiliaries, including colorants and vitamin complexes, may comprise total of 0.1-10% of the composition, the reference does not explicitly teach the claimed amounts of dyes and/or antioxidants. However, it is the Examiner's opinion that the determination of optimal or workable amounts of dyes and/or antioxidants within the reference's generic disclosure by routine experimentation is obvious absent showing of criticality of the claimed concentrations. One having ordinary skill in the art would have been motivated to do this to obtain the desired aesthetic, coloring and/or antioxidant properties of the composition.

11. Claims 7, 12 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loffler in view of Röckl et al. (US 5,690,919).

Loffler applied as above. With respect to Claim 7, Loffler does not explicitly teach the claimed cosmetic oils. However, such oils (e.g. octyldodecanol) are conventionally

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used for their art-recognized purpose, i.e. as emollients and/or carriers. See Röckl et al. @ col. 6, lines 54-60. With respect to Claim 12, Loffler does not explicitly teach the claimed antioxidants. However, the claimed compounds (e.g. vitamin E) are conventionally used for their art-recognized purpose, i.e. as antioxidants. See Röckl et al. @ col. 7, lines 26-27. With respect to Claims 18-20, Loffler does not explicitly teach the claimed mode of application. However, it is known in the cosmetic art to apply skin care compositions by spraying, by means of a roll-on device or by a pump device. See Röckl et al. @ col. 6, lines 35-42. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Loffler such that to employ octyldodecanol. One having ordinary skill in the art would have been motivated to do this because octyldodecanol is a customary cosmetic carrier as suggested by Röckl et al. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Loffler such that to employ tocopherol as an antioxidant. One having ordinary skill in the art would have been motivated to do this to obtain the antioxidant effect and improved stability of the composition as suggested by Röckl et al. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of application of Loffler such that to apply their compositions by spraying, by means of a roll-on device or by a pump device. One having ordinary skill in the art would have been motivated to do this to obtain a variety of products as suggested by Röckl et al.

Conclusion

12. No claim is allowed at this time.
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,294,186; US 6,495,123; US 6,645,476; US 6,660,252; US 2002/0058055; US 2003/0118619; US 2003/0118620.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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